

Group Art Unit: 1772
Examiner: Nordmeyer, P.

Atty. Ref.: 2282-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Wen-Chen Su et al.
Appl. No. : 09/918,652
Filed : March 22, 2000
For : METHOD FOR FORMING MULTILAYER RELEASE LINERS AND
LINERS FORMED THEREBY

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Sir:

This Request for Reconsideration is submitted in response to the office action of May 18, 2005 and further to the personal interview conducted on August 18, 2005.

Counsel thanks Examiner Nordmeyer for the courtesies extended during the interview. It was noted during the interview that both the undersigned attorney and the Examiner have picked up this case in mid-stream. Thus, the interview was helpful for both counsel and the Examiner to review this rather lengthy prosecution.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
on August 22, 2005
Marie B. Bufalo

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As discussed, Examiner Egan issued a final rejection on August 16, 2003 before counsel and Examiner Nordmeyer were involved in this case. The rejection was based primarily on the Reed patent. Prior counsel coordinated with Adrian Hulme for preparation of test data to compare the claimed invention to Reed. As discussed during the interview, the test data compared the claimed invention to the embodiments of Reed where a release coating is applied to an uncoated paper.

Counsel became involved in this case after the test data was developed by Adrian Hulme. The Adrian Hulme test data was presented in a Rule 132 Declaration that was submitted to Examiner Egan. The Rule 132 Declaration showed that the release coating was absorbed extensively into Reed's uncoated paper. In contrast, the release coating of the subject invention defined a substantially continuous release surface on the support layer, with virtually no dispersion into the backing or substrate. Counsel and Examiner Nordmeyer discussed this Rule 132 Declaration during the interview. Examiner Nordmeyer used a yellow highlighter on FIG. 1 of the July 21, 2004 Rule 132 Declaration of Adrian Hulme to highlight the very clearly defined release layer achieved with the claimed invention.

Examiner Egan issued another office action in which he noted that Reed also discloses applying a release coating to a paper substrate that was previously clay coated. Examiner Egan correctly noted that the method of applying the release coating and the backing layer (i.e., substantially simultaneous application with a dual die apparatus) was not relevant in a product claim. Examiner Egan concluded that the July 21, 2004 Rule 132 Declaration was not sufficient.

Reed's application of a release coating to a previously clay coated paper has significant deficiencies. The first of these deficiencies was immediately apparent, and relates to the cost penalty of clay coated paper as compared to the less expensive uncoated substrate. The second deficiency was not immediately apparent, but was found based on additional tests performed by Adrian Hulme. Counsel discussed during the interview the importance of anchoring the release coating properly to the substrate. Counsel explained that the release liner is employed with a pressure-sensitive adhesive label, as set forth in previously amended claim 12. The adhesive label is removed from the release liner and applied to some other surface (e.g., an envelope). Good performance of the adhesive label depends upon the presence of a continuous layer of adhesive. However, a release liner that is not anchored properly may remain on the adhesive label as the label is separated from the multi-layer release liner. Thus, the back of the adhesive label may have regions where the adhesive is covered by the release layer that became separated from the release liner.

Additional tests were conducted by Adrian Hulme and were incorporated into the second Rule 132 Declaration filed on March 28, 2005. That second Rule 132 Declaration showed that the claimed invention provided unexpectedly superior anchoring of the release liner as compared to Reed. As discussed during the August 18, 2005 interview, this superior anchorage of the claimed invention is demonstrated in Table 1 on page 4 of the second Rule 132 Declaration.

Examiner Nordmeyer assumed responsibility for this case shortly after the second Rule 132 Declaration was filed. Examiner Nordmeyer issued a non-final office

action on May 18, 2005. Counsel appreciated the difficulties of picking up this application in mid-stream and suggested a personal interview to Examiner Nordmeyer.

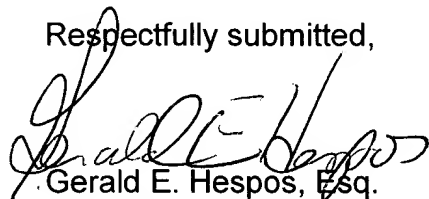
It is believed that the interview was extremely helpful. Counsel emphasized that the second Rule 132 Declaration was not intended to replace the first Rule 132 Declaration. Rather, the two Rule 132 Declarations must be considered in conjunction with one another. As discussed during the interview, the second Rule 132 Declaration refers specifically to the first Rule 132 Declaration. The first Rule 132 Declaration shows the vastly superior performance of the subject invention for achieving a substantially continuous release surface as compared to the minimal release surface when the silicone layer is applied to the uncoated paper of Reed. Again, the continuous release surface was highlighted in yellow by the Examiner during the interview. The second Rule 132 Declaration emphasized the anchorage of the release coating as compared to Reed's application of a release coating to a previously clay-coated substrate. During the course of the interview, counsel directed Examiner Nordmeyer's attention to the first Rule 132 Declaration to demonstrate the reasoning for this vastly improved anchorage. In particular, the FIG. 1 scanning electron micrograph depiction in the first Rule 132 Declaration shows the irregular interfacial area between the release layer and the support layer and the small domains of silicone in the support layer. The Examiner will note that the top boundary of the release layer is substantially smooth and continuous. The bottom boundary of the release layer is less smooth and in fact there are small domains of the silicone dispersed in the support layer as evidenced by the small white dots appearing in the support layer near the release layer.

To summarize, the two Rule 132 Declarations clearly demonstrate that the claimed invention achieves a substantially continuous release surface as shown by FIG. 1 in the first Rule 132 Declaration and a superior anchorage as demonstrated in the second Rule 132 Declaration. The reason for the enhanced anchorage demonstrated in the second Rule 132 Declaration can be found in the scanning electron micrograph in FIG. 1 of the first Rule 132 Declaration. In particular, the scanning electron micrograph shows both the irregular interfacial boundary between the release layer and the support layer and the small domains of silicone from the release layer present in the support layer.

It is believed that the Examiner understood and appreciated the invention much better after the interview. The Examiner indicated informally that Reed did not appear to teach or suggest a multi-layer release liner where the release layer defines a release surface as claimed and where the irregular interface between the release layer and the support layer decreases the propensity of the release layer to separate.

It is believed that the existing claims are patentable over the prior art and allowance is solicited. The Examiner is urged to contact applicants attorney by telephone to expedite the prosecution of this application or to resolve any remaining issues.

Respectfully submitted,



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Date: August 22, 2005